

REMARKS

After entry of this Amendment, the pending claims are: claims 60-62, 65-69, 71-73, and 77-80. The Office Action dated January 15, 2008 has been carefully considered. Claims 63, 64, 70 and 74-76 have been canceled. Claims 1-59 and 81-91 were previously canceled. Claims 60 and 65 have been amended. Claims 62 and 65-68 were previously withdrawn as being directed to non-elected species based on the understanding that the claims would only be restricted to the elected species if no generic claim is held allowable. Independent claim 60 is believed to be generic. Support for the amendments to independent claim 60 can be found throughout the Specification and Drawings and specifically in paragraph Nos. 8 and 27 and drawing Nos. 1A and 1B. No new matter has been added. Reconsideration and allowance of the pending claims in view of the above Amendments and the following Remarks is respectfully requested.

In the Office Action dated January 15, 2008, the Examiner

- objected to the specification for failing to provide proper antecedent basis for the claimed subject matter.
- rejected claims 74 and 75 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claims the subject matter which the Applicants regard as the invention;
- rejected claims 60, 61, 64, 69, 70, 74, 75, and 77 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 103(a) as obvious over U.S. Patent No. 5,491,882 to Watson *et al.* (“Watson”);
- rejected claims 60, 61, 64, 69, 70, and 74-80 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,836,948 to Zuchermann *et al.* (“Zuchermann”) in view of Watson; and

- rejected claims 71-73 under 35 U.S.C. 103(a) as being unpatentable over Watson in view of PCT Published Application No. WO 95/31158 to Taylor (“Taylor”).

SPECIFICATION

The specification was objected to for failing to provide proper antecedent basis for the claimed subject matter. Specifically, the specification was objected to for failing to provide proper antecedent basis for “the coupling portion ... configured to be deformable ... with the deformed diameter between about 10% to about 50% of the unstressed diameter.” It is respectfully submitted that paragraph [0013] of United States Published Application No. 2004/0199255 has been amended to recite: “Furthermore, the prosthesis is produced preferably from an elastic material, so that the central piece can be elastically deformed radially. Preferably the central portion of the prosthesis is capable of deforming from about 10% to about 50%, more preferably from about 15% to about 50% relative to its unstressed diameter.” Support for said amendment appears in originally filed dependent claim 5 which recited that the prosthesis was “produced from an elastic material, which permits elastic deformation of the diameter of the central part (2) at its narrowest place (10) of 10 to 50% and preferably 15 to 50% relative to the unstressed diameter.” As such, it is respectfully submitted that no new matter has been added. In addition, it is respectfully submitted that, at a minimum, one of ordinary skill in the art would appreciate that the limitation “the coupling portion ... configured to be deformable ... with the deformed diameter between about 10% to about 50% of the unstressed diameter” would apply to any prosthesis incorporating a center portion (e.g., coupling portion) produced from an elastic material.

Thus, it is believed that this objection has been overcome, withdrawal of this objection is respectfully requested.

35 U.S.C. 112, SECOND PARAGRAPH

Dependent claims 74 and 75 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. It is respectfully submitted that dependent claims 74 and 75 have been canceled. As such, it is believed that this rejection is moot. Withdrawal of this rejection is respectfully requested.

INDEPENDENT CLAIM 60

Independent claim 60 was rejected under 35 U.S.C. 102(b) as anticipated by Watson. Alternatively, independent claim 60 was rejected as being obvious over Watson. In addition, independent claim 60 was rejected under 35 U.S.C. 103(a) as being unpatentable over Zuchermann in view of Watson.

Without addressing the merits of these arguments and/or combinations, in order to expedite prosecution of the present application, it is respectfully submitted that independent claim 60 has been amended to recite, *inter alia*, an interspinal prosthesis comprising a first half comprising a coupling portion and a process portion, the coupling portion having a bore and a second half comprising a coupling portion and a process portion, the coupling portion configured to be received within the bore of the coupling portion of the first half; wherein one of the first half and the second half includes a plurality of radially extending cams and the other of the first half and the second half includes a plurality of grooves for receiving the plurality of cams when the coupling portion of the second half is received

within the bore of the coupling portion of the first half so that rotation of the first half with respect to the second half is prevented.

It is respectfully submitted that neither Watson and/or Zuchermann, either alone or in combination, disclose, teach or suggest one of the first and second halves including a plurality of radially extending cams and the other of the first and second halves including a plurality of grooves for receiving the plurality of cams when the coupling portion of the second half is received within the bore of the coupling portion of the first half so that rotation of the first half with respect to the second half is prevented.

Therefore, it is respectfully submitted that neither Watson and/or Zuchermann, either alone or in combination, disclose, teach or suggest all of the limitations of independent claim 60. Thus, it is respectfully submitted that independent claim 60 is allowable over the cited prior art. Withdrawal of these rejections and allowance of independent claim 60 is respectfully requested.

Furthermore, as claims 61, 69, 71-73 and 77-80 all depend from independent claim 60, it is submitted that these claims are equally allowable. Withdrawal of these rejections and allowance of claims 61, 69, 71-73 and 77-80 is also respectfully requested.

Claims 62 and 65-68 were previously withdrawn as being directed to a non-elected species based on the understanding that the claims would only be restricted to the elected species if no generic claim is held allowable. Independent claim 60 is believed to be generic. As such, it is respectfully submitted that claims 62 and 65-68 should be allowed as well.

CONCLUSION

No fee is believed due for this submission. If, however, the Commissioner determines otherwise, the Commissioner is authorized to charge any fees which may now or hereafter be due in this application to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact Applicants' attorney at the number listed below.

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Respectfully submitted,

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